

### **REMARKS**

The present amendment is in response to the Office Action dated September 17, 2007. In the present amendment, claims 41 and 46 have been amended and claims 49 – 54 have been cancelled. New claims 55 – 57 have been added. Accordingly, claims 41 – 48 and 55 – 57 are pending in the present application with claims 41, and 46 being the independent claims. Reconsideration and allowance of pending claims 41 – 48 and 55 – 57 in view of the amendments and the following remarks are respectfully requested.

#### **A. Claim Rejections under 35 U.S.C. § 103(a)**

##### **(1) Schmidt (U.S. Patent No. 6,208,872) and in view of Irvin (U.S. Patent No. 6,556,819)**

In the September 17, 2007 Office Action (“Office Action”) claims 41-54 were rejected as being unpatentable over Schmidt (United States Patent No. 6,208,872) in view of Irvin (United States Patent No. 6,556,819) and alternatively in view of Agness (United States Patent No. 6,799,052). In light of the arguments contained herein, the Applicants respectfully request that this rejection be withdrawn.

With regard to independent claims 41, 46, and 49 the Office Action states that Schmidt teaches all of the elements of the claims, except utilizing a GPS functional device contained within the wireless communication device. The Office Action further states that Irvin teaches this limitation. The Office Action states that the combination of Schmidt and Irvin makes the claims obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The subject matter of the claims is restricting communications between wireless communication devices. The Schmidt reference addresses checking to ensure that placing and receiving calls is allowed during roaming, before a call is placed by or received by a potentially roaming wireless communication device. The Irvin reference is directed to utilizing a position sensing system to determine when a device is in a safe zone.

The Office Action states that Schmidt and Irvin are in the same field of endeavor but fails to make any citation to any suggestion in either reference to combine their teachings to achieve the result of restricted communications between wireless communication devices. The Office Action merely states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schmidt and Irvin to have the feature utilizing a global positioning system (GPS) functional device contained within the wireless communication device, in order to enable and disable security features for portable electronic devices based on location of the device, as taught by Irvin (see col. 2, lines 8-10).

However, enabling or disabling security features is not a proper motivation to combine references for the result of restricted communications between wireless communication devices. Thus, the combination is not proper.

Additionally, with respect to Agness, the Office Action states that Schmidt and Agness are in the same field of endeavor but fails to make any citation to any suggestion in either reference to combine their teachings to achieve the result of restricted communications between wireless communication devices. The Office Action merely states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schmidt and Agness to have the feature utilizing a global positioning system (GPS) functional device contained within the wireless communication device, in order to provide a transmission inhibit for digital hand-held cell phones when at specified highway location and specified other restricted locations or during specified restricted times Agness (see col. 2, lines 38-41).

However, providing a transmission inhibit for digital hand-held cell phones when at specified highway location and specified other location or during specified times is not a proper motivation to combine references for the result of restricted communications between wireless communication devices. Thus, the combination is not proper and because none of the references anticipate the claims, as evidenced by the nature of the rejection, Applicant asserts that all claims are presently in condition for allowance.

## 2. Reasonable Expectation of Success

Further, the Office Action has not demonstrated that the combination of the cited references points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis.

Specifically, even after combining the GPS device from Irvin with Schmidt, there is no teaching in either reference to use the GPS device of Irvin to determine if the system ID number of the cellular network in which the mobile station is currently located (the "current system ID number"), matches the system ID number of the mobile station's home system (the "home system ID number"). Yet, this is precisely what Schmidt requires in column 7, lines 46 – 54:

~~the PPT 56.~~ The determinator 40 then checks to see if the mobile station 28 is roaming (block 84). The determinator 40 determines if the system ID number of the cellular network in which the mobile station 28 is currently located (the "current system ID number"), matches the system ID number of the mobile station's 28 home system (the "home system ID number"), which is conventionally stored in the mobile station 28 upon user opening an account. ~~The current system ID number is received at the~~

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Importantly, Schmidt does not identify an actual location for the mobile device, but rather only determines if the mobile device is within the home system. Adding the GPS capability of Irvin does not provide any reasonable expectation that Schmidt would be able to successfully use the GPS information to determine whether the mobile station is within the home system. In fact, the opposite is true because GPS information does not include a current system ID number as required by Schmidt to make its comparison to the previously stored home system ID number. Accordingly, the combination fails to arrive at the present claims because it lacks any reasonable expectation of success in translating the GPS location to the current system ID number.

The addition of Agness does not cure the deficiencies of Schmidt and Irvin. Thus, because no reasonable expectation of success has been shown, Applicant asserts that all claims are presently in condition for allowance.

### 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, Applicant has amended independent claims 41 and 46 to include limitations that emphasize that the GPS location is requested from the GPS device, the GPS location is received from the GPS device, and that the current physical location of the wireless communication device is determined utilizing the current GPS location.

Although Irvin and Agness both teach the use of GPS, neither reference teaches or even suggests translating the GPS location to the current system ID number that is required by Schmidt. Thus, the combination of references fails to result in the ability to determine if the current physical location matches at least one authorized physical location stored in a memory of the wireless communication device, which the Office Action cites Schmidt as teaching.

The combination of references also fails to result in the ability to permit receipt of a call from a received number when the current physical location matches an authorized physical location and the portion of the received phone number matches at least one approved geographic characteristic. These limitations are also cited by the Office Action as being taught by Schmidt.

Furthermore, the present independent claims 41, and 46 include the limitations of “utilizing a controller to determine if a parameter associated with the geographic characteristic stored in the memory indicates that the geographic characteristic is an approved geographic characteristic, the parameter being independent of the physical location of the wireless communication device,” (claim 41) and “a memory for storing at least one area code, a location independent parameter associated with the at least one area code, and at least one authorized location,” (claim 46).

Schmidt, Irvin, and Agness do not teach, suggest, or describe these limitations. Irvin (and alternatively Agness) is cited for teaching determining a physical location of a device. Schmidt, however, does not employ a physical location of a device but rather requires a network system ID number. Furthermore, the ROEF flag taught by Schmidt does not contain the physical location of the device but instead is established for each group phone number and the ROEF flag is used to determine whether call origination is enabled or disabled for that particular number.

Accordingly, because the combination of references does not include all of the limitations of independent claims 41 and 46, Applicant requests that the rejections be withdrawn and a notice of allowance be issued for claims 41 – 48 and 55 – 57.

#### 4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

#### **B. New Claims**

New dependent claims 55 – 57 have been added to further refine the scope of the claimed invention. None of the references teach new claim 55, which includes the further limitation that the current GPS location is an absolute GPS position. Similarly, none of the references teach new claim 56, which includes the further limitation that the current GPS location is a relative GPS position. These new limitations are supported by the specification on page 10.

Additionally, none of the references teach new claim 56, which includes the further limitation that the at least one geographic characteristic stored in the memory comprises local toll charges. Similarly, none of the references teach new claim 57, which includes the further limitation that the at least one geographic characteristic stored in the memory comprises long distance charges. These new limitations are supported by the specification on page 7.

**C. Conclusion**

For all the foregoing reasons, allowance of claims 41 – 48 and 55 – 57 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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